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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,874	12/21/2001	Takayuki Ishikawa	35.C16082	4665
5514	7590	02/25/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			HESS, BRUCE H	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	

1774
DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,974

Applicant(s)

Ishikawa et al.

Examiner

Bruce Hless

Group Art Unit

1774

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 11-14-03 (Election)

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-94 is/are pending in the application.

Of the above claim(s) 1-26 and 59-94 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 27-58 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4 and 6 ☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

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1. The restriction/election required of paper No. 5 is adhere to and made final for the reasons of record.
2. Claims 27-58 are rejected under 35 USC 112 (first paragraph) as being broader than the enabling disclosure as a result of the omission of the limitation that the "forming" step limitation ~~that the "forming" step~~ comprises rubbing the non-volatile liquid after it is applied (see the specification at page 16, lines 18-23).
3. Claims 27, 29-31, 46, 48, 53 and 54 are rejected under 35 USC 102 (b) as being anticipated by the patent to Morikawa et al. (U.S.P. 6,084,620).

At column 56, lines 15-19 and 55, imaged ink jet recorder media having silicone oil applied and pressed into the recording layer are described. It is inherent that the silicone oil will be forced into the recording layer thereby "embedding" the image.

4. Claims 27-29 and 54 are rejected under 35 USC 102 (b) as being anticipated by the parent to Maekawa et al. (JP 56077154).

The ink jet recording sheets of Maekawa et al. have non-volatile liquids forced into the non-imaged voids present in the recording layer. The English abstract of Morikawa et al. does not specify the particular non-volatile liquids employed.

5. Claims 28, 32-34, 44-52 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morikawa et al. in view of applicants' statement of the prior art.

Applicants acknowledge in their specification that particulate receiving layers and porous intermediate layers are well known in the ink jet recording art. The particularly claimed silicone oils ^{are} ~~we~~ also acknowledge as known materials. Consequently, use of these known materials for their concomitant function in the recording material of

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Morikawa et al. would have been obvious to one of ordinary skill in this art in the absence of unexpected results.

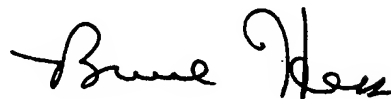
6. Claims 30, 31, 46, 48, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maekawa et al. in view of Morikawa et al.

The primary reference teaches a method of treating imaged ink jet recording media which is after-treated with a non-volatile liquid. The secondary reference teaches the advantages of employing silicone oil as a non-volatile liquid after-treatment on imaged ink jet recording media. Consequently, use of silicon oil as the generically disclosed non-volatile liquid of the primary reference would have been obvious to one of ordinary skill in the art in the absence of unexpected results.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce Hess whose telephone number is (571) 272-1525. The examiner can normally be reached on Monday to Friday 9 Am to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



B. Hess
February 3, 2004

BRUCE H. HESS
PRIMARY EXAMINER